

## REMARKS

Applicants herein traverse and respectfully request reconsideration of the rejection of the claims 1-5 as cited in the above referenced Office Action in view of the remarks set forth below.

### **I. Priority- Pursuant to 35 U.S.C. §120:**

Applicants respectfully traverse the Examiners Objection with respect to Applicants claim for priority. The reference to the '503 application is mainly to highlight the lineage of application serial No. 08/487,596. The specification has been amended to reflect the current status of the various applications indicated in the claim for priority.

The Examiner has taken the position that since the '503 application does not detail the  $\alpha_7$  subunits, the earliest priority to be given to the pending claims drawn to the  $\alpha_7$  subunits is June 7, 1995. For reasons appearing hereafter, Applicants respectfully traverse this objection and maintain that the claims to the  $\alpha_7$  subunit of the human nicotinic acetylcholine receptor vis-à-vis SEQ ID NOs. 11 and 12 are entitled to the priority of each of the '681 and the '193 patents, from each of which the instant application claims priority. In fact, it is Applicant's position that each of the two patents specifically discloses the sequences disclosed in the instant application, i.e., the nucleotide and amino acid sequences of the  $\alpha_7$  subunit as set forth in SEQ ID NOs 11 and 12 respectfully, which are now claimed in new claims 14, 20, 21, 22 and 23, which replace old claims 1-6. For example, the '193 patent was filed on November 30, 1992. Thus, at a minimum, claims drawn to the  $\alpha_7$  subunit of the human nicotinic acetylcholine receptor are entitled to claim priority to November 30, 1992 if not earlier.

### **II. The Rejection of Claims 1-6 Under 35 U.S.C. §101, 112, first Paragraph May Properly Be Withdrawn:**

The Examiner contends that the prohibitions of 35 U.S.C. §112 first paragraph dictate rejection of claims 1-6, now claims 14-23 for the reasons set forth in the outstanding Office Action. Reconsideration of the rejection of the above claims under 35 U.S.C. §101 and §112, First Paragraph is respectfully requested.

Applicants respectfully submit that the new claims 14-23, which replace old claims 1-6 as presented are fully enabled by the specification. Specifically, the claims are drawn to, *inter alia*, the nucleotide sequence of SEQ ID NO: 11 and/or the protein comprising the amino acid sequence of SEQ ID NO: 12, each of which is disclosed in the application and deemed enabled by the Examiner.

Consequently, the Examiner is requested to withdraw the grounds for the outstanding rejection under the first paragraph of section 112.

**III. The Rejection of Claim 1, 4, and 6, Under 35 U.S.C. §102 and §103 As Anticipated or Obvious Over Peng-X et al. May Properly Be Withdrawn:**

Applicants respectfully submit that Peng-X is not prior art as suggested by the Examiner. Specifically, as noted in section I above, Applicants are entitled to the priority date of November 30, 1992 since the '193 patent specifically discloses a nucleotide and amino acid sequence that is identical to each of SEQ ID NO: 11 and 12. It is noted that Applicants have not had a chance to review the text of the PCT application noted in the parental lineage above to ascertain as to whether the  $\alpha_7$  subunit of the human nicotinic acetylcholine receptor as disclosed herein are also described therein. As such, any comments noted herein must not be construed as limiting priority to November 30, 1992. Suffice it to say, that for the purposes of this rejection, claims drawn to the  $\alpha_7$  subunit of the human nicotinic acetylcholine receptor are, at a minimum, entitled to the November 30, 1992 filing date attending each of the '681 and the '193 patents.

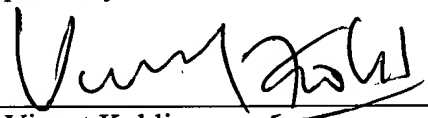
As a consequence, applicants entitlement to the priority date of November 30, 1992 as noted in the claim of priority is sufficient to remove Peng-X et al. as a prior art reference thereby rendering moot the grounds for the above rejection. In light of the above recitation, it is respectfully proposed that the grounds for the rejections under sections 102 and 103 be removed..

For all the above reasons, Applicant respectfully submit that the claims are allowable over the cited references. In view of the foregoing, the application is now believed to be in proper form for allowance and notice to that effect is earnestly solicited.

If the Examiner believes that a telephone conference would be of value, he is requested to call the undersigned counsel at the number listed below.

Any additional fees required in connection with this submission may be taken from Merck Deposit Account No. 13-2755.

Respectfully submitted,

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